



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,071	05/08/2001	Ann Marie Schmidt	0575/55424-Z/JPW/SHS/MVM	3248

7590

05/25/2005

John P. White
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

KAUSHAL, SUMESH

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/851,071

Applicant(s)

SCHMIDT ET AL.

Examiner

Sumesh Kaushal Ph.D.

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 17,20,191 and 35.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 5/2/05
13. ☐ Other: _____.



**SUMESH KAUSHAL
PATENT EXAMINER**

Continuation of 11. does NOT place the application in condition for allowance because: Claims 17, 19-20 and 35 stand rejected under 35 U.S.C. 103(a) for the same reasons of record as set forth in the office action mailed on 01/28/05.

The applicant argues that Gehlsen nor Seftor teaches or suggests admixing cell culture media with an effective amount of an agent known to inhibit the interaction between a tumor cell and an extracellular matrix molecules selected from the group consisting of an amphotericin, a cadherin, an integrin and a hyaluronic acid. The applicant concluded that the cited references in combination fail teach or suggest all elements of the claimed method.

However, applicant's arguments are found NOT persuasive. In instant case Gehlsen clearly teaches the method of evaluating the ability of an agent to inhibit tumor cell spreading using membrane invasion culture system (MICS), which renders the instant invention as claimed prima facie obvious in view of Seftor who teaches the use of MICS for the identification of agents that binds integrin. Therefore the cited art clearly teach a molecule that interacts with tumor cells and extracellular matrices. Since Gehlsen and Seftor both teaches the use of MICS for the evaluation of agent that inhibits tumor cell invasion, there exist a clear motivation to combine the teaching of these references to identify agents that inhibits tumor invasion especially through integrins. Regarding admixing the agents with media Gehlsen specifically teaches mixing of the candidate agent with cell culture media. Similarly Seftor teaches a method for evaluating the ability of an agent to inhibit tumor invasion using membrane invasion culture system especially in context with alphaVbeta3-integrin. Therefore Gehlsen clearly teaches the method of evaluating the ability of an agent to inhibit tumor cell spreading, which renders the instant invention prima facie obvious in view of Seftor who teaches the use of membrane invasion culture system for the identification of agents that binds integrin(s). In addition one would have a reasonable expectation of success, since evaluation of a candidate compound that inhibit extracellular-matrix/tumor-cell interaction using a tumor attachment assay or a tumor invasion assays had been routine in the art the time the instant invention was made. .



SUMESH KAUSHAL
PATENT EXAMINER